

REMARKS

Applicant's attorney believes this Amendment conforms to the Revised Format announced by the PTO. However, if this is incorrect in any respect, applicant and applicant's attorney are ready to bring the Amendment into conformity with that format promptly after notice of any nonconformity from examiner.

Examiner's acceptance of the drawings filed with this application is noted.

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph. Main (independent) claims 1, 6 and 7 have been amended herein to overcome the basis cited by examiner for that rejection.

With all due respect, applicant objects to the statements of further rejection of claims 1-7 and of rejection of claims 8-9 on prior art, as failing to afford applicant the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity, for failure of examiner to clearly articulate the rejections early in the prosecution process, as required by MPEP §706. The rejections are purported to be based on 35 U.S.C. §103(a), but none of the statements of rejection comply with MPEP §706.02(m) "Form Paragraphs for Use in Rejections Under 35 U.S.C. 103."

According to the Action, "claims 1-7 are rejected under 35 U.S.C. §103(a) the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102 as being unpatentable over Fisher, US 5,507,485 in view of Germain, US 5,319,548 in further view of Fano US 6,317,718." Substantially the same language is used in examiner's rejection of claims 8-9, absent Fano. Is applicant being tasked to respond to an obviousness rejection under section 103(a), a rejection relating to an allegation of a lack of common ownership under section 103(c), or an anticipation rejection under section 102, or perhaps all three? Applicant's attorney must acknowledge that he has never encountered this type of rejection terminology in a long career of patent prosecution. Applicant assumes that examiner intended to restrict the rejection to section 103(a), but requests clarification, and a further opportunity to respond if other rejections are contemplated by this phraseology.

The rejections under 35 U.S.C. §103(a) are respectfully traversed. As clearly presented

in applicant's specification, the entire thrust of applicant's invention resides in giving a person or persons who are about to play a round of golf and who may be contemplating the use of a totally unfamiliar or not entirely familiar cart-based or otherwise mobile golf course navigation and information system, an opportunity to take advantage of a gratis trial period at the time of sign-up at the course club house. The cost of using such a system to play a round of golf is not unsubstantial. But prior to applicant's invention as disclosed and claimed herein, the player was faced with making a non-refundable decision to bear the added cost of use of the golf navigation/information system (or to forgo its use and, for example, be assigned a cart with system graphics or display rendered inactive), with the possibility of discovering in relatively short order that he or she had made a costly mistake.

As stated at page 4 of applicant's specification, a principal objective of the present invention is to provide a method and apparatus which gives the player a reasonable but limited opportunity to evaluate such a system during play of the course, and to make an election by a specified point in play of the round on whether or not to continue using the system to complete the round.

The rejection cites Fisher and Fano (the latter being applied as "in further view of" in the rejection of claims 1-7, but not 8-9), neither of those references having the slightest relevance to the essence of applicant's invention. At the very point of departure of the latter, the examiner cites Germain, which, it is submitted, likewise lacks any relevance to the very gist of the invention. Germain does little more than disclose an interactive pocket-size scorecard for use in playing golf and which is intended to replace conventional scorecards, with the addition of a few "bells and whistles." The passages cited by examiner in support of the rejections pertain only to a payment mode of the system that allows the golfer/user to pay in cash, by credit or debit card, or by membership account for "items that may include greens fees, system fees, club house meals, pro shop items and services such as caddies and lessons." [Column 11, lines 44-48]. Examiner needn't have cited Germain, since systems like Fisher's have the same capability, except that it is called a cashier.

In fact, examiner admits "Germain does not teach a gratis trial period for the player." Unfazed by this awesome lack of teaching or suggestion in the "key" reference, examiner simply turns around and states "but it would have been obvious to one of ordinary [sic] in the art to allow the Germain [sic] to include a gratis trial period for each golfer because it would attract more golfers to use the system." Warming to the argument, the examiner goes on to say "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the Fisher [sic] to include a gratis trial period for each golfer, and after the trial period, the golf [sic] require [sic] to pay for using the system as taught by the modified method of Germain because it would attract more golfers to use this golf course system, and it would also [sic] easier for the owner of the golf course system to collect money from the golfers for using the system."

Well, gee, this obviousness rejection stuff is easy -- when we don't have a reference, we can just find something in the vicinity and use the applicant's own disclosure to kluge everything together. Except that is not how the system works. When the statute refers to "obvious at the time the invention was made to a person having ordinary skill in the art," it means in the sense of the *Graham v. Deere* test imposed by the U.S. Supreme Court. Further, MPEP §706.02(j) states:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.* [Emphasis added].

In the present situation, none of the references themselves contain any teaching or suggestion of a gratis trial period for a system of the type claimed by applicant. So even if there were any semblance of motivation to modify the references cited by examiner or to combine them, it would not result in applicant's method or apparatus as disclosed and claimed. Nor would

the prior art references when combined teach or suggest all of applicant's claim limitations; specifically, using claim 1 as an example, "invoking a gratis trial period less than an entire round of play of the course during which the cart display of such information is activated for a golfer commencing use of the cart; and automatically rendering said cart display of such information inactive at the end of said gratis trial period unless, by that point of play, a payment authorization for completion of the round with activated cart display has been made by a golfer using the cart." And to add to the glaring lack of any substance or cohesiveness in the rejections, examiner has liberally borrowed -- nay, swiped -- from applicant's own disclosure to "make the case" for alleged obviousness.

For the foregoing reasons, applicant submits that the section 103(a) rejections are clearly erroneous and should be withdrawn.

Claims 10 and 11 are newly added to further the comprehensiveness deserved by the invention.

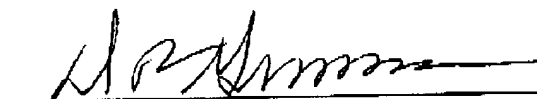
The other references cited by examiner have been reviewed but not found to cure the deficiencies of the applied art.

Except for the amended and new claims, all claims recited above and pending herein are in their original form.

Reconsideration and withdrawal of the rejections, and allowance of the application, are solicited.

Respectfully submitted,

KIRK BINGEMAN, ET AL.



Donald R. Greene
Registration No. 22470
P.O. Box 12995
Scottsdale, AZ 85267-2995
Telephone: 480-488-9895
Fax: 480-488-5654

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